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EXAMINER

DAVIS, DEBORAH A

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte INDU MANI, NIRMALA NAIR, ANISHA PARGAL,
SUBARNA SAHA, NAGALAKSHMI SURENDRA, and SHILPA VORA

Appeal 2011-000127
Application 10/559,115
Technology Center 1600

Before DEMETRA J. MILLS, MELANIE L. McCOLLUM, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF CASE

Claims 1-9 stand rejected and appealed (App. Br. 3). Claim 1, the only independent claim, is representative and reads as follows:

1. A cosmetic skin lightening composition, comprising 0.1 - 50% by weight of extracts of plants from the genera *Symplocos* and *Rubia*; the extract of *Symplocos* being selected from *Symplocos recemosa*, *Symplocos paniculata*, *Symplocos cochinchinensis* or mixtures thereof; the extract of *Rubia* being *Rubia cordifolia* wherein the extracts are primary skin lightening agents within the composition.

Grounds of Rejection

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Osumi¹ et al in view of Deckner² et al.

FINDINGS OF FACT

The Examiner's findings of fact are set forth in the Answer at pages 3-5.

Discussion

ISSUE

The Examiner concludes that

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well known in the art for the same purpose (e.g., in skin compositions for skin conditioning) and for the following reasons. It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the

¹ Osumi Kazuhisa et al., JP 2003-055184, published Feb. 26, 2003.

² Deckner et al., US 5,968,528, issued Oct. 19, 1999.

prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose.

(Ans. 4-5.)

Appellants argue that Osumi does not even remotely describe the use of vitamin B3 and extracts from the plants of the genus *Rubia cordifolia*. Osumi fails to describe the extract of *Rubia* used in conjunction with *Symplocos* extract. (App. Br. 8.) Appellants rely on Tables 1 and 2 of the Specification for a showing of synergistic results.

The issue is: Does the cited prior art support a rejection of the claimed invention for obviousness? Does Appellants secondary indicia of non-obviousness overcome the Examiner's prima facie case of obviousness?

PRINCIPLES OF LAW

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citations omitted). In order to determine whether a prima facie case of obviousness has been established, we consider the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the relevant art; and (4) objective evidence of nonobviousness, if present.

This type of motivation has been recognized often by the predecessor of our reviewing court, which has held that it is prima facie obvious to

combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the same purpose. *In re Susi*, 440 F.2d 442, 445 (CCPA 1971); *In re Crockett*, 279 F.2d 274, 276-77 (CCPA 1960). The idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 626 F.2d 846, 850 (CCPA 1980). Here the art recognized skin care properties of each of the described agents would have provided one of ordinary skill in the art with ample suggestion of their combination in the composition as claimed. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

In *KSR*, 550 U.S. at 415 the Supreme Court rejected a rigid application of a teaching-suggestion-motivation test in the obviousness determination. The Court emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.* at 417. Obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Finally, obviousness is determined in view of the sum of all of the relevant teachings in the art, not isolated teachings in the art. *See In re*

Kuderna, 426 F.2d 385, 389 (CCPA 1970); *see also In re Shuman*, 361 F.2d 1008, 1012 (CCPA 1966).

ANALYSIS

We agree with the Examiner's fact finding, statement of the rejection and responses to Appellants' arguments as set forth in the Answer. We find that the Examiner's evidence supports a prima facie case of obviousness for the reasons of record. We provide the following additional comment.

Appellants argue that Osumi fails to describe the extract of *Rubia* used in conjunction with *Symplocos* extract. (App. Br. 8.) Obviousness is determined in view of the sum of all of the relevant teachings in the art, not isolated teachings in the art. In the case before us both the composition of Osumi comprising *Symplocos* and the composition of Deckner were known as skin care compositions which may also lighten skin. Deckner discloses that anti-inflammatory agents for use in skin care compositions include Manjistha extracted from plants in the genus *Rubia*, particularly *Rubia cordifolia*. (Col. 28, ll. 18-20.) Deckner further states that anti-inflammatory agents enhance the skin appearance and contribute to a more uniform and acceptable skin tone or color. (Col. 27, ll. 5-10.)

If a technique such as the inclusion of an anti-inflammatory has been used to improve a skin care composition, and a person of ordinary skill in the art would recognize that it would improve similar skin care compositions in the same way, using the anti-inflammatory would have been obvious unless its actual application is beyond his or her skill. *See KSR*, 550 U.S. at 417. "The [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court

can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. Appellants have not shown that the inclusion of Deckner’s anti-inflammatory in the skin care composition of Osumi is beyond the skill of one of ordinary skill in the art.

Appellants rely on Tables 1 and 2 of the Specification for a showing of synergistic results. For the reasons provided in the Answer pages 8-9, we agree with the Examiner that the Appellants’ evidence of synergy of the combination of *Rubia* with *Symplocos* is inconclusive.

The obviousness rejection is affirmed.

CONCLUSION OF LAW

The cited references support the Examiner’s conclusion of obviousness.

Appellants’ secondary evidence supporting patentability does not overcome the examiner’s prima facie case of obviousness.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc